

Atty. Dkt. No. 054707-0868

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Rejection under 35 U.S.C. 112, ¶ 1

Claim 58 has been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

Disclosure of a representative number of species may satisfy the written description requirement for a claimed genus. *Enzo Biochem Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 1322, 63 USPQ2d 1609, 1615 (Fed. Cir. 2002). The present application identifies twelve generic chemical structures and over a hundred individual compounds as examples of NAALADase inhibitors (see, for example, the application at pages 16-62). In addition to these examples, the application incorporates by reference a host of other NAALADase inhibitors (see, for example, the application at page 114). Methods for assaying NAALADase inhibiting activity were also well known in the art as of the filing date of this application (see, for example, U.S. Patent Nos. 5,672,592, 5,880,122, 5,968,915, 6,025,344 and 6,046,180). In view of the application's disclosure and information that was available at the time the application was filed, persons of ordinary skill in the art would recognize that applicants had possession of the generic scope of claim 58.

In support of this rejection, the Office states:

The specification discloses examples of structures of some compounds with the scope of what is claimed. However, there is no evidence that there is any per se structure/function relationship between the disclosed NAALADase inhibitor compounds and any others that might be found using the claimed method. Structural identifying characteristics of the group of NAALADase inhibitors are not disclosed. Therefore the claimed invention is not supported by an adequate written description.

Atty. Dkt. No. 054707-0868

Office action, paper number 12, page 2. The Office has not set forth any authority requiring evidence of a "per se structure/function relationship between the disclosed NAALADase inhibitor compounds and any others that might be found using the claimed method." Even assuming, for the sake of argument, that such authority exists, the written description requirements would nevertheless be satisfied. The NAALADase enzyme is clearly defined in the specification and, otherwise, well known in the art. The application's description of compounds by their function of inhibiting the NAALADase enzyme inherently specifies common structural characteristics that would facilitate binding to the NAALADase enzyme.

Based on the foregoing reasons, applicants respectfully request withdrawal of this rejection.

Allowable Subject Matter

Applicants acknowledge with appreciation the Office's recognition of allowable subject matter in claims 25, 26 and 50-57.

Atty. Dkt. No. 054707-0868

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date December 16, 2003

FOLEY & LARDNER
Customer Number: 29728
Telephone: (202) 295-4163
Facsimile: (202) 672-5399

By Suet M. Chong

Suet M. Chong
Attorney for Applicants
Registration No. 38,104